

**UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF OHIO
WESTERN DIVISION**

The Gorilla Glue Company,

Case No. 1:17-cv-193

PLAINTIFF,

Judge: Michael R. Barrett

vs.

**CONSENT ORDER AND
PERMANENT INJUNCTION**

GG Strains LLC,

DEFENDANT.

Plaintiff The Gorilla Glue Company ("Plaintiff" or "Gorilla Glue") and Defendant GG Strains LLC ("Defendant" or "GG Strains") have agreed to settle the matters at issue between them without further litigation and have stipulated, by and through counsel, to the entry of a Consent Order and Permanent Injunction as set forth below. They do so in settlement and resolution of the above-captioned action. The parties waive and release all errors in the proceedings and the right to appeal from this Consent Order and Permanent Injunction. The Court being duly advised, it is hereby ORDERED, ADJUDGED, AND DECREED as follows:

NATURE OF THE ACTION

1. This is an action for trademark infringement, dilution, unfair competition and cybersquatting under federal, state, and common law. Plaintiff contends, among other things, that Defendant is unlawfully advertising and selling products and services under a confusingly similar name to Gorilla Glue's trademarks, in violation and dilution of Gorilla Glue's trademark rights. Defendant denies Plaintiff's allegations and claims.

PARTIES, JURISDICTION AND VENUE

2. Plaintiff Gorilla Glue is an Ohio corporation having a principal place of business at 2101 East Kemper Road in Sharonville, Ohio, 45241.

3. Defendant GG Strains a Nevada limited liability company having a principal place of business at 9360 West Flamingo Road #110-212 in Las Vegas, Nevada, 89147.

4. Defendant has been duly served with the Summons and Complaint.



5. This Court has jurisdiction over the subject matter of this action pursuant to 15 U.S.C. § 1121 and 28 U.S.C. §§ 1331, 1338(a), and 1338(b). Pursuant to 28 U.S.C. § 1367, this Court also has supplemental jurisdiction over Gorilla Glue's state-law claims because those claims are so related to Gorilla Glue's federal Lanham Act claims that they form part of the same case or controversy. This Court also has diversity jurisdiction under 28 U.S.C. § 1332 because Gorilla Glue and Defendant are citizens of different states (Ohio and Nevada respectively) and the amount in controversy exceeds \$75,000 exclusive of interest and costs.



6. The parties consent to personal jurisdiction and venue for purposes of this matter only.



AGREED STATEMENT OF FACTS



7. Gorilla Glue owns the following valid and subsisting U.S. federal registrations for its GORILLA GLUE marks (the "GORILLA Registrations"):

	Mark	Goods/Services	Status/Registration Date
1	<u>GORILLA GLUE</u> Reg. No.: 2449800	(Int'l Class: 01) all purpose industrial glue (Int'l Class: 16) all purpose household glue	Registered May 8, 2001

	Mark	Goods/Services	Status/Registration Date
2	<p><u>GORILLA GLUE</u> <u>GORILLA BRAND</u> <u>PREMIUM GLUE and</u> <u>Design</u></p>  <p>Reg. No.: 2069032</p>	<p>(Int'l Class: 01) all purpose industrial glue made of moisture cured polyurethane, used to bond wood, stone, metal, ceramics, and plastic (Int'l Class: 16) all purpose household glue made of moisture cured polyurethane, used to bond wood, sone, metal, ceramics, and plastic (Int'l Class: 25) clothing, namely, shirts and hats</p>	Registered June 10, 1997
3	<p><u>GORILLA BRAND</u> <u>PREMIER GLUE</u> <u>GORILLA PVC and</u> <u>Design</u></p>  <p>Reg. No.: 2328025</p>	<p>(Int'l Class: 01) cement used to bond polyvinyl chloride (pvc) pipe and pipe fittings</p>	Registered March 14, 2000
4	<p><u>GORILLA</u></p> <p>Reg. No.: 4026349</p>	<p>(Int'l Class: 16) adhesives for stationery or household use; super glue for stationery or household use; wood glue for household use; polyurethane glue for stationery or household use; adhesive tape for stationery or household use</p>	Registered September 13, 2011

	Mark	Goods/Services	Status/Registration Date
5	<u>GORILLA and Design</u>  Reg. No.: 4026350	(Int'l Class: 16) adhesives for stationery or household use; super glue for stationery or household use; wood glue for household use; polyurethane glue for stationery or household use; adhesive tape for stationery or household use	Registered September 13, 2011
6	<u>GORILLA</u> Reg. No.: 3782762	(Int'l Class: 01) adhesives, other than for stationery or household purposes; construction and industrial adhesives; all purpose industrial glue; epoxy glue for general bonding and repair purposes; super glue for general bonding and repair purposes; polyurethane glue for general bonding and repair purposes; wood glue for general bonding and repairing, and for construction and industrial purposes	Registered April 27, 2010
7	<u>GORILLA</u> Reg. No.: 4809495	(Int'l Class: 17) adhesive sealants for general use; caulking; and adhesive tape for industrial or commercial use	Registered September 8, 2015
8	<u>GORILLA</u> Reg. No.: 4515217	(Int'l Class: 03) abrasive pads and blocks	Registered April 15, 2014
9	<u>GORILLA and Design</u>  Reg. No.: 3782761	(Int'l Class: 01) adhesives, other than for stationery or household purposes; construction and industrial adhesives; all purpose industrial glue; epoxy glue for general bonding and repair purposes; super glue for general bonding and repair purposes; polyurethane glue for general bonding and repair purposes; wood glue for general bonding and repairing, and for construction and industrial purposes	Registered April 27, 2010

	Mark	Goods/Services	Status/Registration Date
10	<u>GORILLA and Design</u>  Reg. No.: 4813797	(Int'l Class: 17) adhesive sealants for general use; caulking; and adhesive tape for industrial or commercial use	Registered September 15, 2015
11	<u>GORILLA TOUGH</u> Reg. No.: 3381899	(Int'l Class: 16) glue for stationery or household use; adhesive tape for stationery or household purposes	Registered February 12, 2008
12	<u>GORILLA</u> <u>INCREDIBLY</u> <u>STRONG and Design</u>  Reg. No.: 4955512	(Int'l Class: 01) adhesives, other than for stationery or household purposes; construction and industrial adhesives; all purpose industrial glue; epoxy glue for general bonding and repair purposes; super glue for general bonding and repair purposes; polyurethane glue for general bonding and repair purposes; wood glue for general bonding and repairing, and for construction and industrial purposes; contact cements (Int'l Class: 16) adhesives for stationery or household use; all purpose household glue; super glue for stationery or household use; wood glue for household use; polyurethane glue for stationery or household use; adhesive tape for stationery or household use (Int'l Class: 17) adhesive sealants for general use; caulking; adhesive tape for industrial or commercial use	Registered May 10, 2016

	Mark	Goods/Services	Status/Registration Date
13	<p><u>GORILLA</u> <u>INCREDIBLY</u> <u>STRONG 100%</u> <u>TOUGH and Design</u></p>  <p>Reg. No.: 4959865</p>	<p>(Int'l Class: 01) adhesives, other than for stationery or household purposes; construction and industrial adhesives; all purpose industrial glue; epoxy glue for general bonding and repair purposes; super glue for general bonding and repair purposes; polyurethane glue for general bonding and repair purposes; wood glue for general bonding and repairing, and for construction and industrial purposes; contact cements (Int'l Class: 16) adhesives for stationery or household use; all purpose household glue; super glue for stationery or household use; wood glue for household use; polyurethane glue for stationery or household use; adhesive tape for stationery or household use (Int'l Class: 17) adhesive sealants for general use; caulking; adhesive tape for industrial or commercial use</p>	Registered May 17, 2016
14	<p><u>GORILLA TAPE</u></p> <p>Reg. No.: 3105182</p>	<p>(Int'l Class: 16) adhesive tape for stationary or household purposes (Int'l Class: 17) adhesive tape for industrial or commercial use</p>	Registered June 13, 2006
15	<p><u>GORILLA TAPE</u> <u>INCREDIBLY</u> <u>STRONG 100%</u> <u>TOUGH and Design</u></p>  <p>Reg. No.: 3336141</p>	<p>(Int'l Class: 16) adhesive tape for stationery or household purposes (Int'l Class: 17) adhesive tape for industrial or commercial use</p>	Registered November 13, 2007

8. Moreover, Registration Nos. 2449800, 2069032, 2328025, 4026349, 4026350, 3782762, 3782761, 3381899, 3105182 and 3336141 are incontestable pursuant to 15 U.S.C. § 1065.

9. Defendant does not challenge that the trademarks represented by the GORILLA Registrations are valid, subsisting, and enforceable, and that Gorilla Glue has the exclusive right to use such trademarks on and in connection with the goods for which each is registered.

10. Defendant acknowledges that products bearing the marks registered under the GORILLA Registrations and similar marks (collectively, the "GORILLA GLUE Marks") are and have been sold online and in highly visited stores all over the country.

11. Defendant acknowledges that Gorilla Glue has advertised its products throughout the United States, including without limitation its website located at [<gorillatough.com>](http://gorillatough.com)¹ and through advertising and marketing in various media channels.

12. GG Strains is a provider of services, genetic verification and clothing related to certain strains of cannabis. Among other things, GG Strains has advertised and licensed the names for strains of cannabis known as Gorilla Glue #1, Gorilla Glue #4 and Gorilla Glue #5 (the "GORILLA GLUE # Marks").

13. GG Strains authorizes select cultivators and dispensaries around the country to market its strains, and utilizes genotyping to verify the authenticity of the subject cannabis. In most instances, and subject to individual state cannabis regulations, GG Strains sets branding rules for how the subject cannabis can be labeled and advertised.

14. GG Strains has operated the website [<gorillaglu4.com>](http://gorillaglu4.com) in connection with its business described above.

15. GG Strains has also filed to register certain relevant marks with state trademark systems. In Colorado, GG Strains registered the word trademark "Gorilla Glue #4" in the class "005 Pharmaceuticals" with a product description of "Medical cannabis, the specific Gorilla Glue #4 hybrid cannabis plant strain." Also in Colorado, GG Strains registered a logo that includes the words "GORILLA GLUE" in the class "031 Natural Agricultural Products" with the same product description.

¹ Gorilla Glue also owns the web domain [<gorillaglu4.com>](http://gorillaglu4.com), which re-directs to [<gorillatough.com>](http://gorillatough.com).

16. In Washington, there are logos registered in the name of GG Strains, using its business name, "GG Strains" along with an image of a smoking gorilla.

17. On March 24, 2017, Gorilla Glue filed suit against GG Strains in the above-captioned case. GG Strains denies liability with respect to Gorilla Glue's claims.

18. In order to resolve this dispute without trial of any issue of law or fact and without any admission of wrongdoing, Gorilla Glue and GG Strains agree to the following conclusions and relief, which is hereby ORDERED by the Court, permanently enjoining the parties:

DISPOSITION AND ORDER

(a) GG Strains acknowledges Gorilla Glue's exclusive right, title, and interest in and to its GORILLA GLUE marks, including without limitation the GORILLA Registrations, and any other GORILLA-formative trademarks and trademarks, tradenames, design marks, logos, and other identifiers including the term Gorilla (or a confusingly similar term) (all together, the "GORILLA Marks"), in the United States. GG Strains shall not expressly or impliedly represent that it has any ownership interest in, any rights to, or any relationship with, the GORILLA Marks in the United States.

(b) The parties have entered into a Settlement Agreement dated September 19, 2017 ("Settlement Agreement"). Through the Settlement Agreement and this Consent Order and Permanent Injunction, the Parties agree to the relief set forth herein.

(c) The parties shall not disparage or make negative comments about each other, about each others' products or services, or about each others' conduct or activities in connection with bringing, responding to or settling this lawsuit.

(d) Within 12 months of September 19, 2017, GG Strains shall cease using, and thereafter shall not again use, the word "Gorilla," an image of a gorilla, or the GORILLA Marks in the United States in connection with its goods or services, except that a "History" page or

reference on its website may remain until January 1, 2020. During the 9-month period following December 18, 2017, GG Strains shall only use said words, image or Marks in reference to what strains were "formerly known as" or within said "History" webpage or reference.

(e) GG Strains shall disable the website located at <gorillaglu4.com> except that it may redirect to a different website until January 1, 2020, and may display an explanation of the redirection for nine months following September 19, 2017. On January 1, 2020, GG Strains shall transfer the <gorillaglu4.com> domain to Gorilla Glue, which will not be thereafter activated or used.

(f) Effective January 1, 2020, GG Strains shall assign any and all right, title and interest in and to the GORILLA GLUE Marks and the GORILLA GLUE # Marks to Gorilla Glue, and shall cooperate in any documentation that must be executed to effectuate the assignment. Any cost associated therein shall be incurred by Gorilla Glue.

(g) GG Strains, its employees, agents, officers, directors, shareholders (including but not limited to Ross E. Johnson and Jackie D. Peabody), subsidiaries, related companies, affiliates, distributors, dealers, authorized or certified cultivators, authorized or certified dispensaries, growers or sellers of one or more of GG Strains' strains identified previously with the GORILLA GLUE # Marks, and all persons in active concert or participation with any of them:

- i. Shall not use the word "Gorilla," an image of a gorilla that has been registered by Gorilla Glue, the GORILLA GLUE Marks, the GORILLA GLUE # Marks, or any other trademarks, trade names, or other identifiers that are the same as or similar theretocannabis, in any

manner or form (collectively, the "Prohibited Marks"), in connection with any goods or services in the United States, except that:

(A) GG Strains and its licensees may use the Prohibited Marks for up to 90 days after September 19, 2017;

(B) GG Strains and its licensees may use the Prohibited Marks, if preceded by a different name and the words "formerly known as," for 12 months after September 19, 2017;

(C) a new licensee of GG Strains that becomes a licensee within the first 12 months after September 19, 2017, may use the Prohibited Marks, if preceded by a different name and the words "formerly known as," for 12 months after the date on which it becomes a licensee;

(D) if a current licensee of GG Strains is required by state law or regulation not to change the name of a cannabis plant that has already been registered with the applicable state agency or system using a Prohibited Mark, it may comply with said state law or regulation; and (E) if a new licensee of GG Strains that becomes a licensee within the first 12 months after September 19, 2017 is required by state law or regulation not to change the name of a cannabis plant that has already been registered with the applicable state agency or system using a Prohibited Mark at the time that the new licensee becomes a licensee of GG Strains, it may comply with said state law or regulation.

- ii. Shall not apply to register, register or assert any rights, priority or ownership in any mark containing or similar to the word "Gorilla," an image of a gorilla that has been registered by Gorilla Glue, or the GORILLA Marks, in any forum in the United States, including state or federal, and including administrative, agency, or judicial.

(h) This Court has continuing jurisdiction to interpret and enforce the terms and provisions of the parties' Settlement Agreement and this Consent Order and Permanent Injunction pursuant to the pronouncements of *Kokkonen v. Guardian Life Insurance Company of America*, 511 U.S. 375, 381-382 (1994). In the event of breach of any of the obligations or covenants of this Consent Order, this Court shall retain jurisdiction to enforce its terms.

(i) Service by mail upon GG Strains, addressed to GG Strains at 9360 West Flamingo Road #110-212, Las Vegas, Nevada 89147, of a copy of this Consent Order and Permanent Injunction entered by the Court is deemed sufficient notice under Federal Rule of Civil Procedure 65. It shall not be necessary for Defendant to sign any form of acknowledgement of service.

(j) The parties shall bear their own attorneys' fees and costs.

(k) Subject to the terms of this Consent Order and the parties' Settlement Agreement, this action and all claims asserted herein shall be and hereby are terminated and dismissed, with prejudice.

IT IS SO ORDERED.

Dated: September 21, 2017

/s/ Michael R. Barrett
MICHAEL R. BARRETT
United States District Judge

Consented and Agreed To:

For THE GORILLA GLUE COMPANY:

/s/ Thomas F. Hankinson

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CERTIFICATE OF SERVICE

I certify that on September 19, 2017, I electronically filed the foregoing Consent Order using the Court's CM/ECF system. Electronic notification will be sent to all attorneys of record by operation of the Court's electronic filing system.

/s/ Thomas F. Hankinson